UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,987	12/19/2001	Joseph J. Tallal JR.		2337

34725 7590 11/19/2003

CHALKER FLORES, LLP
12700 PARK CENTRAL, STE. 455
DALLAS, TX 75251

EXAMINER	
GONZALEZ, JULIO C	
ART UNIT	PAPER NUMBER
2834	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,987	TALLAL ET AL.	
	Examiner	Art Unit	
	Julio C. Gonzalez	2834	

-- Th MAILING DATE of this communication app ars on the cov r she t with the corr spondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. Examiner greatly appreciates the clarification and changes done to the drawings on 09/10/03. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 34 (proposed processor in amended figures filed on 09/10/03). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specifications (page 8, lines 1-3, 18-20) and the claims disclosed that the wind turbine generates electricity. However, wind turbines themselves are not able to generate electricity. Wind turbines only assist an input to a generator, which produces electricity. As described in the specification, such system will not be able to generate electricity. Also, the specifications provided no information as to how the system can be remotely controlled. No new matter should be entered. Even though it may be common to use a generator in combination with a wind turbine, it must be disclose that a generator functions with the wind turbine in order to have a complete *working system*. It must also be disclosed where this generator may be since the location of the generator may vary, depending on the invention and such, affects the scope of the invention. It would be helpful to point out where in the drawings this generator may be located.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey in view of Bergeron, Jr. and Roskey.

Hickey discloses a system for generating electricity having a wind turbine 16d disposed within an enclosure of the building (see figure 1). Also, two or more air ducts 154 are disclosed so that wind may enter the building (see figure 9). Moreover, it is shown that the system has a controller 44 (see figure 3, 4) However, Hickey does not disclose explicitly having a plurality of ducts and intermediate ducts.

On the other hand, Bergeron, Jr. discloses for the purpose of providing an efficient air circulation system for a building, air intakes 22 and a building having a plurality of intake ducts, exhaust ducts and intermediate ducts (see figure 1, 3, 5, 6, 9, 14 and 15).

However, neither Hickey nor Bergeron, Jr. discloses that some of the air ducts may be mounted in a non-axial relationship to the wind turbine and that the air scoop may change the position.

On the other hand, Roskey discloses for the purpose of providing a ventilation system that is fuel efficient, air scoop 104 (see figure 13), which can change the position and that the air ducts may be a non-axial relationship to a wind turbine (see figures 1 and 15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a system for generating electricity as disclosed by Hickey and to modify the invention by having intermediate ducts for the purpose of providing an efficient air circulation system for a building as disclosed by Bergeron, Jr. and changing the position of the scoops for the purpose of providing a ventilation system that is fuel efficient as disclosed by Roskey.

6. Claims 3-7, 9, 10, 15, 16, 18, 20-22, 24, and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, Bergeron, Jr. and Roskey as applied to claim 1 above, and further in view of Shingaki.

The combined device discloses all of the elements above. However, the combined device does not disclose explicitly having an air intake mounted on the exterior of a building.

On the other hand, Shingaki discloses for the purpose of reducing dew condensation by improving air circulation within a building, an air intake 72 mounted on an exterior of the building (see figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combined system as disclosed above and to mount an air intake on the exterior of the building for the purpose of reducing dew

condensation by improving air circulation within a building as disclosed by Shingaki.

7. Claims 2 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, Bergeron, Jr. and Shingaki and Roskey as applied to claims 1 and 18 above, and further in view of Baumgartner et al.

The combined device discloses all of the elements above. However, the combined device does not disclose that the air ducts may have a larger cross sectional area at one end.

On the other hand, Baumgartner et al discloses for the purpose of making a wind turbine, which is able to rotate efficiently a generator so that enough power may be produced in order to drive loads, an air duct having a larger cross sectional area than the second end of the duct (see figure 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combined system as disclosed above and to modify the invention by using a duct with different cross sectional areas for the purpose of making a wind turbine, which is able to rotate efficiently a generator so that enough power may be produced in order to drive loads as disclosed by Baumgartner et al.

Response to Arguments

8. Applicant's arguments filed 09/10/03 have been fully considered but they are not persuasive.

Hickey discloses a system wherein a wind turbine is use. Bergeron, Jr. discloses a system wherein a blower, which may function as a wind turbine (see figures 2, 5). Moreover, Bergeron, Jr. discloses a system that funnels/delivers wind through a series of channels as well as Hickey. It would be obvious to use such system in a house or a building if it were require to channel a wind current to a wind turbine.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references used deal in a manner to use the wind current and channeling such wind current to a desire location.

Allowable Subject Matter

11. Claims 8, 17, 25 and 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. More specifically, the prior art does not teach the limitations of having an air flow focusing device disposed within the enclosure between the air ducts and the air intake of the wind turbine (claims 8 and 25) and having a cross sectional area of the wind turbine exhaust larger that the cross sectional area of the two or more air ducts (claims 17 and 33).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is (703) 305-1563. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jcg

November 7, 2003

BURTON S. MULLINS
PRIMARY EXAMINER